

REMARKS

Claims 1, 2, 10, 11, 62-65, 69 and 70 have been rejected in the Office Action of September 2, 2003. Claims 1, 10 and 11 have been cancelled. Claims 2, 62, 69 and 70 have been amended. Thus, claims 2, 62-65, 69 and 70 are pending. Claims 71-80 have been newly added to further clarify the novel features of the present invention. These newly added claims mirror claims that were canceled without prejudice in a preliminary amendment. The newly added claims find support in the specification and, thus, no new matter has been added. Accordingly, Applicant respectfully submits that all claims are in condition for allowance.

Applicant respectfully requests further examination and reconsideration of the application in view of the following remarks.

1. Section 102(e) Rejection Over Collart (U.S. Publication No. US 2002/0091575 A1)

Claims 1, 2, 10 and 11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. US 2002/0091575 A1 to Collart (“Collart”). Claims 1, 10 and 11 have been cancelled. Applicant respectfully disagrees with Examiner and traverses this rejection with regard to remaining claim 2.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. *See MPEP § 706.02(a).* Furthermore, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); *see MPEP § 2131*. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); *see MPEP § 2131*. For the reasons set forth below, Applicant

respectfully submits that each and every element set forth in the claims is not anticipated by Drew.

Claim 2 recites a DVD having “a first digital work” and “a second digital work” that has “a first outcome, which awards a prize” and “a second outcome, which does not award a prize.” In contrast, Collart merely describes a method and device for tracking usage of a recording medium based on an identifier that is stored on the recording medium. The identifier may correspond to an individual user of the recording medium. (paragraph 0017). Moreover, an identifier can be selected at random where “a prize is issued, in lottery fashion to a person associated with the identifier.” (paragraph 0021). Additionally, Collart merely describes the use of a DVD in a promotional marketing effort in the form of a lottery, where a “DVD identifier can be used to provide an award to a user of a certain disc.” (paragraph 0247).

Collart therefore lacks the “first digital work” and “second digital work,” called for by claim 2. Moreover, Applicant’s claim 2 not only calls for two digital works, but also calls for the second digital work to be associated with two outcomes. In contrast, in Collart, the outcomes are associated with an identifier, not with the digital work itself. The outcomes of Applicant’s claim 2 are not limited to whether the user of the DVD is associated with “the selected DVD identifier,” as in Collart. (paragraph 0247).

Accordingly, each of the claim elements are not disclosed or suggested in the Collart reference. It is respectfully submitted that these claims are now in condition for allowance. Reconsideration is respectfully requested.

2. Section 102(e) Rejection Over Simpson (U.S. Publication No. US 2001/0049627 A1)

Claims 1, 2, 10, 11 and 62 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. US 2001/0049627 A1 to Simpson (“Simpson”). Claims 1, 10 and 11 have been cancelled. Claims 2, and 62 have been amended. Applicant respectfully disagrees with Examiner and traverses this rejection.

As described above, Applicant’s claim 2 recites a DVD having “a first digital work” and “a second digital work” that has “a first outcome, which awards a prize” and “a second outcome, which does not award a prize.” In contrast, Simpson merely describes a method of “distributing electronic coupons that includes the presentation of multimedia information.” (paragraph 0017). Additionally, Simpson requires the use of an access code or authorization in order to procure or view any particular coupons (paragraphs 0037, 0042, 0072-77). Authorization in Simpson may be obtained when a user give actual information regarding, for example, the user’s geographical area, gender, age, hobbies, interests, occupation or any other information which may be useful in customizing the coupons or discount offers (paragraphs 0072-77).

Claim 2 incorporates a “first digital work” and a “second digital work, elements lacking in Simpson. Additionally, Applicant’s claim 2 incorporates “a first outcome, which awards a prize” and “a second outcome, which does not award a prize,” which is associated with the second digital work, elements also lacking in Simpson. Simpson merely recites the use of “multimedia” presentations in association with the distribution of electronic coupons, such as “games, stories, movies, or other entertainment items.” (paragraph 0031). Accordingly, each of the claim elements, namely, a DVD containing a first and second digital work, wherein the second digital work has a first and second outcome, are not disclosed in the Simpson reference.

Claim 62 describes a method of awarding a prize that incorporates “storing a digital work,” “storing a first game play,” “employing said first game play having one of a first outcome and second outcome,” and “selectively awarding a prize based upon the first outcome of said first game play, and providing a second game play based upon the second outcome of said first game play.” In contrast, Simpson merely recites the use of games in distributing electronic coupons, where “users may be rewarded for reaching particular scores or levels of achievement in those games with particular coupons or other discount offers.” (paragraph 0073). Simpson does not disclose or suggest providing a “second game play based upon the second outcome of said first game play,” as recited in Applicant’s claim 62.

Accordingly, each of the claim elements are not disclosed or suggested in the Simpson reference. It is respectfully submitted that these claims are now in condition for allowance. Reconsideration is respectfully requested.

3. Section 103(a) Rejection Over Simpson ((U.S. Publication No. US 2001/0049627 A1))

Claims 63-65, 69 and 70 stand rejected under 35 U.S.C. § 103(a) as being obvious over Simpson. Applicant has amended claims 69 and 70 to more clearly define the invention. Applicant respectfully disagrees with Examiner and traverses this rejection.

The three basic criteria for establishing a prima facie case of obviousness, set forth in MPEP § 706.02(j), are listed below:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As stated previously, the method of claim 62 incorporates “selectively awarding a prize based upon the first outcome of said first game play, and providing a second game play based upon the second outcome of said first game play.” Moreover, Applicant’s claims 63 through 65 are dependent on claim 62 and, thus, incorporate the same elements of claim 62. Simpson merely describes the presentation of multimedia information in distributing electronic coupons. (paragraph 0017). Upon achieving a “predetermined score in the game,” Simpson merely discloses “reward[ing] the user with access to a particular coupon, gift certificate, or other discount.” Simpson does not teach or suggest providing a second game play based upon the second outcome of the first game play.

Amended claim 69 recites “displaying at least one question” after displaying the advertisement, receiving “one response to said at least one question,” employing [a] game play having one of a first outcome and a second outcome” and “awarding a prize based upon the first outcome of said game play or displaying a digital work based upon the second outcome of said game play.” Amended claim 70 is dependent on claim 69 and, thus, incorporates the same elements as claim 69. Moreover, claim 70 recites use of a commercial as the advertisement and use of a clue that is associated with the commercial. In contrast, Simpson does not disclose or suggest the use of questions or clues associated with commercials, which is distinct from the use of coupons as described in Simpson.

Commercials and the associated methods and systems of applicant’s claims are distinguishable from coupons, as commercials impart brand image and heightened awareness through the combined use of sight, color, sound and motion (often evoking strong emotions from viewers) as opposed to the static display of a coupon that may merely be a ticket that entitles the bearer to certain benefits, such as a cash refund or a discount on a purchase. Furthermore, commercials have a certain time duration, such as the general thirty-second television clip, in which to convey the goods, an intended image, a secondary message, etc.

The content of coupons, on the contrary, are immediately perceived. Moreover, many companies spending considerable amounts of time and money in producing and presenting commercials. As such, commercials represent substantial investments for companies.

Certain aspects of the present invention address needs particular to viewer-acceptance of commercials. For example, the commercial's message and content may not be fully displayed (as opposed to that of a coupon, which is immediately perceived) if a user fast-forwards through the commercial once the commercial begins or skips the commercial entirely. Thus, the present invention, specifically amended claims 69 and 70, addresses this problem by including clues with the commercial and questions relating to the commercial after it is displayed. Simpson does not recognize the problem or the source of the problem itself, and thus does not address it.

Simpson merely describes the use of multimedia content to draw a user to engage the CD-ROM to obtain exposure of coupons; it does not teach or suggest the problem associated with the display of commercials or the use of clues and questions related to a commercial to prolong a viewer's interest in such commercial. Simpson merely discloses a system and method whereby a user inputs marketing-related biographic and demographic information and, in turn, receives a collection of coupons that may be customized according the user's preferences. Claim 69, on the contrary, requires that a user input "at least one response to [] at least one question," where the "questions is associated with said advertisement."

It is respectfully submitted that Applicant's invention is not obvious in light of Simpson, and, accordingly, claims 63-65, and amended claims 69 and 70 are in condition for allowance. Reconsideration is respectfully requested.

CONCLUSION

It is respectfully submitted that all claims in the application are now allowable.

Reconsideration and withdrawal of all rejections are respectfully requested. Favorable notice to this effect and early Notice of Allowance are earnestly solicited.

Should the Examiner have any questions and in order to expedite prosecution of this Application, the Examiner is encouraged to contact the undersigned directly. Should the Examiner not consider the present claims allowable, this should be considered a request for an interview to discuss the merits of the case.

Dated: 2/2/04

Respectfully submitted,

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